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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,871	07/02/2001	Heather A. Bowen-Leaver	2870/485	1385

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/897,871

Applicant(s)

BOWEN-LEAVER ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-11,13,15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-11, 13, 15, and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Pri ority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of Amendment filed on July 23, 2003. Claim rejections made under 35 U.S.C. § 112, second paragraph, as indicated in the Office action dated April 23, 2003 are withdrawn in view of applicants' amendment. Claim rejections made under § 103 as indicated in the same Office action are withdrawn in view of applicants' remarks. New rejections are made. Claims 1-3, 5-11, 13, 15, and 16 are pending.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diec (US 6468551 B1).

Diec teaches a W/O microemulsion having finely dispersed oil droplets. See col. 2, lines 15 – 24. The reference teaches that micellar compositions have particle diameters of less than about 100 nm and appear clear and transparent. See col. 2, lines 25 – 27. The reference teaches that oil phase can be hydrocarbon oils, and “furthermore advantageously have a content of cyclic linear silicone oils” in addition to other oil phase. See col. 25, lines 48 – 53. Cyclomethicone is particularly mentioned. See col. 25, lines 48 – 53; instant claim 5. The reference teaches that the content of the oily phase range from 0.01-30 % by weight. See col. 25, lines 54 – 56. The reference also teaches that O/W emulsifiers are used in the amount ranging from 0.01-15 % by weight. See col. 25, lines 57 – 66. See instant claim 2. The reference also teaches that it is disadvantageous to have high amount of surfactant.

While the reference fails to teach the "difference in complex viscosity" of the composition, examiner notes that this limitation is a physical property of the claimed composition. Since the prior art teaches the claimed composition obvious, examiner views that the recited physical property is an obvious property of the prior art.

Given the ranges of the oil phase and the emulsifiers in Diec, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have optimized the weight amount of the emulsifiers as suggested by the reference because of an expectation of successfully producing a topical microemulsion gel composition with lesser amount of surfactants.

2. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Claudelli (US 4026818) in view of Diec (US 6468551 B1).

Claudelli teaches transparent ringed gels for cosmetic use, comprising mineral oil, water, and 5-9 percent by weight of (2 ethyl 1,3-dihydroxy) 2-propyl oleamide. See col. 1, lines 5 – 63. The reference teaches transparent gels are obtained due to the small particle size of the dispersed droplet, which allows rapid absorption on skin of active ingredients contained in the composition. The reference teaches using low ratios of emulsifier to oil could be achieved, which is less costly. The reference teaches that it is well known in the art that clear ringed gel appeal to consumers. See col. 1, lines 5-9. The reference teaches that minimum of 5 % of emulsifier (2-ethyl-1,3-dihydroxy) and maximum amount of 19.5 % of an oil phase (isostearic acid and mineral oil).

While the reference fails to teach the 5:1 ratio of oil phase and emulsifier as claimed by applicants, examiner notes that differences in concentration will not support

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the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. See MPEP § 2144.05. Since the general conditions of the instant claims are disclosed in Claudelli, examiner views that one having ordinary skill in the art would have discovered the optimum or workable ranges by routine experimentation. Lowering the concentration of emulsifier is also suggested in the reference.

The reference also fails to teach using silicone oil.

Diec, discussed above, teaches "advantageously" using silicone oil in the oil phase. See col. 25, lines 43-53. The reference also teaches using the emulsifiers and the oily phase within the claimed weigh ratio. The reference also teaches that it is advantageous to have lower amount of emulsifiers.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Claudelli by adding silicone oil as suggested by Diec because of an expectation of successfully producing an improved cosmetic gel.

3. Claims 7-11, 13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claudelli and Diec, and further in view of Kakoki et al. (U.S. Pat. No. 5,162,377) ("Kakoki").

Claudelli and Diec fail to teach the shearing process of instant claims.

Kakoki teaches the process of making a transparent emulsion cosmetic composition by applying high-shearing treatment to the composition. In the reference high shearing force treatment is carried out by high-pressure homogenization using

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emulsifiers such as Microfluidizer which is used in the present invention, or Manthon Gaulin, under a pressure of 500 psi or more. See col. 4, line 44 – col. 5, line 23. The Examples 4-13 shows treating the emulsion compositions with Manthon Gaulin at least 5-10 times to obtain transparent aqueous compositions.

Given the teaching in the combined references that high-pressure homogenization process is used to produce a nanoemulsion, one of ordinary skill in the art at the time the invention was made to have would have known looked for prior arts such as Kakoki for specific types of homogenizer and method steps to carry out the process to make the said composition, and treated the pre-emulsion with high shearing force to produce transparent compositions.

Response to Arguments

Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

No claims are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
October 27, 2003


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

11/3/03